



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,779	07/10/2003	Kenneth A. Scott	075234.0113	2000
5073	7590	10/29/2008		
BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980			EXAMINER D'AGOSTINO, PAUL ANTHONY	
			ART UNIT 3714	PAPER NUMBER
			NOTIFICATION DATE 10/29/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptomail1@bakerbotts.com  
glenda.orrantia@bakerbotts.com

### Office Action Summary

**Application No.**

10/616,779

**Applicant(s)**

SCOTT ET AL.

**Examiner**

Paul A. D'Agostino

**Art Unit**

3714

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8500)  
Paper No(s)/Mail Date 7/1/2008
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Inventor's Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This responds to Applicant's Arguments/Remarks filed 06/27/2008. Claims 21-40 have been amended. Claims 21-40 are now pending in this application.

#### ***Response to Amendment***

1. This acknowledges and approves the replacement sheets (Figs. 3 and 4). The objection to the drawings is withdrawn.

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 21-40 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: In Claim 21 for example, there are presented a first option and a selection of the first option and a second option and a selection of the second option, however, only the second option is received from the player. There is no further claim language to address receiving of the first option by the player. Appropriate attention is required.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 21-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,830,068 to Brenner et al. (Brenner) of record in view of U.S. Patent No. 6,450,887 to Mire et al. (Mir) of record.

In Reference to Claim 21 (and representative of the remaining claims)

As shown in Fig. 3, Brenner discloses a method of placing a pari-mutuel wager comprising displaying a plurality of tracks where a plurality of races, i.e. events, are

available, receiving a selection of the first one of the plurality of tracks [196], receiving a selection of a first one of the plurality of events [204], and receiving a first wager associated with a first event that is at the first track wherein the first wager is based at least in part on the first race [212]. After placing a wager, two or more options are displayed to the player [258], wherein a first option is to switch tracks ("Main Menu" option in menu [258] allows player to select a second one of the plurality of tracks and place a second wager associated with a second event that is at the second track, wherein the second wager is based at least in part on the first game) and a second option is to switch events ("More Bets Other Race" option in menu [258] allows a player to select a second one of the plurality of events, i.e. races, that are available at the first track and to place a third wager associated with a third event that is at the first track, wherein the third wager is based at least in part on the second game).

Mir et al. discloses allowing a player to first select a type of casino-style pari-mutuel wagering game, e.g. "Thoroughbred Mania", "Thundering Hounds" or "Live Racing", prior to selecting any other wagering parameter (col. 8, lines 14-19; col. 8, lines 62-67). If the player selects the "Live Racing" game option, the player is then allowed to select a track where this game is available and place a bet accordingly (col. 9, lines 24-30). Additionally, Fig. 3b of Mir et al. displays an "Exit to Menu" option, which returns a player to the game selection screen of Fig. 3a (col. 8, lines 58-59). Thus, Mir et al. discloses a selectable option that allows a player to select a new game.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the betting options disclosed in Brenner with the ability to first

select a desired game and display a plurality of tracks where the selected game is available, as disclosed by Mir, the inventions are analogous race-track type betting systems in the same field of endeavor. Further, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Brenner as modified by Mir is silent wherein player selection of a different game than the first game at the first track without redisplaying to the player the track selection frame. However, one of ordinary skill in the art would recognize that the natural progression in the art of gaming and on-line virtual wagering would improve the robustness of the design by providing increased player options in the form of more selections and choices. If a player is at one virtual location (at one virtual track) and wishes to either select a different game, track, or other feature then it would only require only routine skill in the art to make more play variations available.

It would therefore be obvious to one of ordinary skill in the art at the time the invention was made to allow a player to choose a new game without leaving his chosen track because of the ability to make more play variations available.

### ***Response to Arguments***

7. Applicant's arguments filed 6/27/2008 have been fully considered but they are not persuasive. Applicant argues (see Applicant's Arguments/Remarks pages 17-18)

Brenner as modified by Mir fails to teach "allow player to select a game, different from the first game, at the first track without redisplaying to the player the track selection frame." Examiner respectfully disagrees and has addressed this point in the rejection of claim 21.

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. D'Agostino whose telephone number is (571)270-1992. The examiner can normally be reached on Monday - Friday, 7:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John M Hotaling II/  
Supervisory Patent Examiner, Art Unit 3714

/Paul A. D'Agostino/  
Examiner, Art Unit 3714